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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                 | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------------|------------------|
| 10/730,606   | 12/08/2003  | Patrick J. Sweeney   | 029815-0105                         | 4015             |
| 26371  | 7590        | 06/20/2005           |                                     |                  |
| FOLEY & LARDNER<br>777 EAST WISCONSIN AVENUE<br>SUITE 3800<br>MILWAUKEE, WI 53202-5308 |             |                      |                                     |                  |
|  |             |                      | EXAMINER<br>GHERBI, SUZETTE JAIME J |                  |
|  |             |                      | ART UNIT<br>3738                    | PAPER NUMBER     |

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/730,606

Applicant(s)

SWEENEY, PATRICK J.

Examiner

Suzette J Gherbi

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/10/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both an insert and a central canal on page 5, line 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 3738

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-13, 15-18, 25-27, 30-33, 35-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Ganjianpour 6,716,250. The invention is understood, and Ganjianpour discloses the invention as currently claimed comprising: a body (neck 19) having a central canal; extending there through; and a shaft coupled to the body (the shaft is located on the screw 30) and extending through the central canal wherein the shaft is *capable of being interchanged after implantation of the prosthesis by removing the shaft and replacing the shaft (30) with a replacement shaft without dislodging the body from the patient (all functional and capable of being performed by Ganjianpour)*; wherein the shaft is coupled to the body via insertion of the shaft through an end of the central canal nearest an articular surface of the prosthesis (the articular end is the surface of body/neck 19 see fig. 7 where a head can be attached); wherein the device is configured for a hip joint or shoulder joint (the device can be put into an animal of varying sizes to replace there shoulder joint); wherein the shaft is a nail; wherein the replacement shaft is longer than the shaft (see fig. 7 how it extends); wherein an insert is coupled to the body and extending at least partially into the central canal (read col. 7, lines 63-64 "groove shaft 26 inserted).

***Claim Rejections - 35 USC § 103***

4. Claims 3-4, 14, 28-29, 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganjianpour in view of Pennig 5,375,956. Ganjianpour has been disclosed above however, Ganjianpour does not specify the term Morse. Ganjianpour does however have a tapered section that is coupled to the shaft (see col. 8, line 51-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a Morse taper lock as claimed because the taper of Ganjianpour is tapered and the Morse taper is well known in the art (as admitted in applicants specification) and is a matter of design modification and thus not novel. Ganjianpour shaft has an unthreaded head recess. Pennig 5,375,956 as an example of modified screw with shaft and head and the tool used to removal. It is also obvious that a "remover" such as screw driver device can be used to remove the shaft from the insert. If the head of the screw has threads than a threaded tool would be used to unscrew the device (see Pennig 5,375,956 as an example of modified screw with shaft and head and the tool used to removal.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huebner 5,961,555; Gerbec et al. 2004/0117024 ; and Gerbec et al. 2003/0204269 all show related material.

Art Unit: 3738

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4751.
7. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.
8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Suzette J-J Gherbi  
09 June 2005